REMARKS

Claims 1-14 and 16-20 are all the claims pending in the application. By this Amendment, Applicant amends claims 1, 4-7, and 12-14 to further clarify the invention. In addition, Applicant cancels claim 15 and adds claims 17-20.

Preliminary Matters

As preliminary matters, the Examiner has failed to indicate approval of the drawings that were filed with the above-identified application. Applicant respectfully requests the Examiner to indicate acceptance of the drawings in the next office communication.

The Examiner has failed to return the form PTO/SB/08 filed with the Information Disclosure on July 17, 2003. Applicant respectfully requests the Examiner to return the initialed form PTO/SB/08 with the next office communication. For the Examiner's convenience, a copy of the form PTO/SB/08 as filed on July 17, 2003 is enclosed.

Finally, the Examiner has failed to acknowledge the claim for priority under 35 U.S.C. §119, as well as the receipt of a certified copy of the priority document filed on July 17, 2003. Therefore, Applicant respectfully requests the Examiner to check the appropriate boxes on the Form PTO-326 indicating that the claim for priority is acknowledged and that the certified copy of the priority document has been received.

Summary of the Office Action

The Examiner rejected claims 1-8 and 10-16 under 35 U.S.C. § 102(e) and claim 9 under 35 U.S.C. § 103(a).

Prior Art Rejections

The Examiner has rejected claims 1-8 and 10-16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,842,766 to Brockway et al. (hereinafter "Brockway") and claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Brockway in view of U.S. Patent No. 6,654,797 to Kamper (hereinafter "Kamper"). Applicant respectfully traverses these rejections in view of the following comments.

To be an "anticipation" rejection under 35 U.S.C. § 102, the reference must teach <u>every element and recitation of the Applicant's claims</u>. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention.

Of the rejected claims only claims 1, 5-7, and 14 are independent. Independent claim 1 is a unique combination of features including:

> wherein the first node and the second node are
> at least one of parameterized and configured
> by storing node-specific data, the node-
> specific data relates to the node being at
> least one of parameterized and configured,
>
> wherein, when newly connected to the network,
> each of the first and second nodes is adapted
> to transmit via the communication channel the
> stored node-specific data of the respective
> node to the other of the first and second
> nodes,
>
> wherein each of the first and second nodes
> comprises a memory in which the transmitted
> node-specific data for the other node is
> stored, the other node being at least one of
> parameterized and configured, and
>
> wherein, when the first node is replaced or is
> resuming operation, the second node transmits

> the node-specific data of the first node via
> the communications channel to the first node
> and the first node executes at least one of
> parameterizing and configuring the first node
> using the transmitted node-specific data.

The Examiner alleges that claim 1 is directed to a network and is anticipated by Brockway. In particular, the Examiner alleges that Brockway's server and a client are equivalent to the first and second nodes as set forth in claim 1. Applicant respectfully disagrees. Applicant has carefully studied Brockway's discussion of the server/client computer system, which lacks having the first and second nodes, each storing the transmitted configuration or parameter data of the other node and having the second transmit to the first node the first node's configuration or parameter data when the first node is resuming operation or has been replaced.

For example, in the illustrative, non-limiting embodiment of the present invention, each node configures itself by storing the appropriate information. After the newly added node is configured, it signals the configuration data to its neighboring nodes, which store the received data in their respective memories. When one of the nodes is replaced or resumes operation, the node being restored simply requests its configuration data from the neighboring node(s) and, based on the configuration data, configures itself. That is, in the exemplary, non-limiting embodiment, there is a network of reciprocity. Each node stores configuration data of the neighboring nodes and upon request can provide this data to the neighboring node. It will be appreciated that the foregoing remarks relate to the invention in a general sense, the remarks are not necessarily limitative of any claims and are intended only to help the Examiner better understand the distinguishing aspects of the claims mentioned above.

Brockway relates to a system having a dedicated server and a number of clients. The server-client system of Brockway is configured to store, on a client, server configuration

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information relating to a peripheral device connected at the client and parameter settings for the peripheral device. The information is updated as changes occur. After the client has been disconnected from the system and the peripheral device uninstalled, the peripheral device is automatically installed and the parameter settings restored without requiring significant user interaction when the client reconnects. The automatic installation and restoring of the peripheral device is performed even if the client connected to this peripheral device is connected to a different server by transmitting the server configuration information stored on the client to the server upon connection or reconnection (*see* Abstract; Fig. 4; col. 6, lines 1 to 11).

Specifically, Brockway discloses having a dedicated connection between the server and a client (Fig. 1; col. 3, lines 31 to 40). The server establishes a session with each client, *i.e.*, provides a desktop and allocates the server resources for the client (col. 3, lines 48 to 55). The peripheral device of a client, such as a printer when first connected to the server, is configured by the server. The server sends to the client of the peripheral device its configuration information for the peripheral device as well as any updates that were made (Figs. 2 and 3; col. 5, lines 3 to 19 and lines 47 to 62). Accordingly, after the client disconnects from the server, the configuration information for the peripheral device is not lost but is stored in the client. As a result, the next time the client connects to the server or to another server, it automatically transmits the configuration information for its peripheral device to the server, and no further manual configuration is necessary (Fig. 4; col. 6, lines 5 to 19).

Brockway, however, only relates to a dedicated server that services its clients. Brockway fails to disclose or suggest a reciprocity network between the nodes. Specifically, Brockway fails to teach or suggest the node being configured by storing its own configuration data. That is,

Brockway only discloses configuring a peripheral device by storing the data related to the peripheral device on the server and on the client computer. In Brockway, the server is not being configured by storing its own configuration information on the server, and the client computer is not being configured by storing its own configuration information on the client computer. In short, Brockway fails to teach or suggest having the first and second nodes configure themselves by storing the respective parameter or configuration data. Moreover, in Brockway, the information being send to the client only relates to the configuration of the peripheral device and not of the server.

Additionally, Brockway fails to teach or suggest having a server and a client each store its own configuration information and the configuration information of the other entity transmitted from that other entity. In Brockway, the server allocates a desktop space and other resources for the client as well as creates configuration data for a peripheral device and the client only stores the configuration data created by the server. That is, Brockway does not teach or suggest the system of reciprocity as set forth in the unique features of claim 1.

Finally, Brockway can be thought of as an antithesis of the features in claim 1. In Brockway, it is the client that establishes the connection and transmits the configuration data for its peripheral device. In Brockway, upon the client establishing a connection to the server, the server does not send the configuration data to the client so that the client can configure itself but instead it is the client that resumes operation and that also sends the configuration data for its peripheral device to the server.

In summary, Brockway fails to teach or suggest having the server send the client computer configuration data or the parameter data to the client when the client is being replaced

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or is resuming operation. In Brockway, it is <u>the entity that resumes operation that sends the data</u>.

Moreover, Brockway lacks having the client and the server not only store its own respective

configuration information but also transmit its configuration information to each other. Indeed,

Brockway's system is a client-server system where a dedicated server services the clients.

Brockway fails to teach or suggest having a reciprocal system, where the nodes service each

other.

Therefore, the unique combination of features set forth in claim 1, including:

> ...the first node and the second node are at
> least one of parameterized and configured by
> storing node-specific data, the node-specific
> data relates to the node being at least one of
> parameterized and configured,

> ...when newly connected to the network, each
> of the first and second nodes is adapted to
> transmit via the communication channel the
> stored node-specific data of the respective
> node to the other of the first and second
> nodes,

> ...each of the first and second nodes
> comprises a memory in which the transmitted
> node-specific data for the other node is
> stored, the other node being at least one of
> parameterized and configured, and

> ...when the first node is replaced or is
> resuming operation, the second node transmits
> the node-specific data of the first node via
> the communications channel to the first node
> and the first node executes at least one of
> parameterizing and configuring the first node
> using the transmitted node-specific data.

are not taught or suggested by Brockway, which lacks each entity storing its own configuration

data as well as the transmitted configuration data of another device transmitted by that other

device and which also lacks sending to the entity resuming operations the information for

configuring this entity that resumes operations. In short, Brockway fails to teach or suggest the

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network of reciprocity as suggested by the unique features of claim 1. For at least these exemplary reasons, Applicant respectfully submits that claim 1 is patentably distinguishable (and is patentable over) Brockway. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claim 1. Claims 2-4 are patentable at least by virtue of their dependency on claim 1.

Moreover, claim 2 recites: "the first node and the second node are adjacent in the network." The Examiner alleges that Brockway discloses these unique features of claim 2 in col. 3, lines 31 to 46 (see page 3 of the Office Action). Applicant respectfully submits that col. 3, lines 31 to 46 only disclose a system having clients connected to the server over the network. In Brockway, however, there is no indication whether the client and the server are adjacent. Since Brockway only teaches having a client connected to the server over a network, the rejection is improper as it lacks "sufficient specificity" required under 102. "[A]nticipation under § 102 can be found only when the reference discloses exactly what is claimed and that where there are differences between the reference disclosure and the claim, the rejection must be based on § 103 which takes differences into account." *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985); MPEP § 2131. Therefore, for at least this additional reason, Applicant respectfully submits that claim 2 is patentably distinguishable from Brockway.

Next, independent claims 5, 7, and 14 recite features similar to the features argued above with respect to claim 1. Accordingly, arguments presented with respect to claim 1 apply by analogy here. For at least analogous reasons, claims 5, 7, and 14 are patentably distinguishable from (and are patentable over) Brockway. Applicant respectfully requests the Examiner to

withdraw this rejection of claims 5, 7, and 14 and their dependent claims 8, 10-13, and 16. With

respect to claim 15, this rejection is rendered moot because claim 15 was canceled.

Finally, claim 6 recites, among a number of unique features: "wherein the node is one of

a switch, a stored-program controller, and a measuring transducer, and wherein the node-

specific data relates to executing at least one of configuration and parameterization one of the

switch, the stored-program controller, and the measuring transducer."

Brockway, as explained in greater detail above, only discloses a server-client system,

where the server and client computer communicate with each other in regards to the

configuration information for the peripheral device of the client. Brockway, however, fails to

teach or suggest a communication between the personal computers, switches, controller, and/or

transducers and where the information being communicated relates to the actual device

communicating and not to its peripheral device.

For at least these exemplary reasons, Applicant respectfully submits that claim 6 is

patentably distinguishable (and is patentable over) Brockway. Therefore, Applicant respectfully

requests the Examiner to withdraw this rejection of claim 6.

Next, Applicant respectfully traverses the § 103 rejection. In particular, the Examiner

alleges that claim 9, which depends on claim 7, is rejected under 35 U.S.C. § 103(a) as being

obvious over Brockway in view of Kamper. Applicant has already demonstrated that Brockway

does not teach or suggest all of the unique features of the independent claim 7. Kamper is relied

upon only for its teachings of having a defective node (see pages 6-7 of the Office Action).

Clearly, Kamper does not compensate for the above-identified deficiencies of Brockway.

Together, the combined teachings of these references would not have (and could not have) led

the artisan of ordinary skill to have achieved the subject matter of claim 7. Since claim 9 is

dependent upon claim 7, it is patentable at least by virtue of its dependency.

The Examiner alleges that one of ordinary skill in the art would have been motivated to

combine the references in order to restore the network with a server (see page 7 of the Office

Action). Applicant respectfully disagrees. Applicant respectfully submits that one of ordinary

skill in the art would not have been motivated to combine the two references in the manner

suggested by the Examiner and, even if somehow combined, would result in an unworkable

combination.

A critical step in analyzing the patentability of claims pursuant to section 103(a) is

casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in

the art, guided only by the prior art references and the then-accepted wisdom in the field. *See In

re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (*citing In re Dembiczak*, 175 F.3d 994, 999,

50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Close adherence to this methodology is especially

important in cases where the very ease with which the invention can be understood may prompt

one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the

invention taught is used against its teacher." *Kotzab*, 55 USPQ2d at 1316 (*quoting W.L. Gore &

Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. *In re Kotzab*, 55

USPQ2d at 1316 (*citing In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir.

1998). Thus, every element of a claimed invention may often be found in the prior art. *Id.*

However, identification in the prior art of each individual part claimed is insufficient to defeat

patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a

combination of the elements disclosed in the prior art, there must be some motivation, suggestion

or teaching of the desirability of making the specific combination that was made by the

applicant. *In re Kotzab*, 55 USPQ2d at 1316 (*citing In re Dance*, 160 F.3d 1339, 1343, 48

USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125,

1127 (Fed. Cir. 1984)). Although a reference need not expressly teach that the disclosure

contained therein should be combined with another, ***the showing of combinability, in whatever***

form, must nevertheless be "clear and particular," (emphasis added). *Winner International*

Royalty Corporation v. Ching-Rong Wang, 53 USPQ2d 1580, 1586-87 (Fed. Cir. 2000)

(citations omitted).

In the present case, one of ordinary skill in the art would not have been motivated to

combine Brockway and Kamper. Kamper is no different from the manual conventional

techniques because Kamper discloses storing the configuration information on an information

carrier, *i.e.* the smart card, and inserting that smart card into the new server. One of ordinary

skill in the art confronted with a problem of automating the configuration of a peripheral device

such as the printer would not have turned to the manual technique of Kamper.

Moreover, Brockway discloses that when the printer is first connected to the server, it

must be configured or installed on the server. That is, if a new printer is being used, it needs to

be installed on the server (col. 4, lines 24 to 30). In other words, storing the configuration

parameters of the old printer in a smart card would not avoid the need to install the new printer

on the server. In other words, Brockway and Kamper cannot be validly combined in the

rejection under 35 U.S.C. § 103.

For at least this additional reason, Applicant respectfully submits that claim 9 is patentable over the combined teachings of Brockway and Kamper. Therefore, it is appropriate and necessary for the Examiner to withdraw this rejection of claim 9.

New Claims

In order to provide more varied protection, Applicant adds claims 17-20. Claims 17-20 are patentable at least by virtue of their dependency on claim 1 or claim 14.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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